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HP Docket No. 10980726-4

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 21, 25, 40, 43-47, 72, 74, 76-77, 85-86, 113-114, 117, 123-126, and 129 have been amended, and new claims 130-134 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all elected claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections**Rejection Under 35USC §101**

Claims 123-124 have been rejected under 35 USC §101 as directed to non-statutory subject matter.

In view of this rejection, claims 123-124 have been amended as suggested by the Office to claim "A computer-readable medium storing a program".

In view of the foregoing, it is submitted that the rejections have been overcome and should be withdrawn.

Rejection Under 35USC §112 First Paragraph

Claim 77 has been rejected under 35 USC §112, paragraph 1, as failing to comply with the enablement requirement.

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The Office states that “[i]t is not possible for the user to mark the form for a particular enhancement and that same form to include the results of that enhancement. The results of the enhancement would have to appear on a different form than the form designating those enhancements.” (Office Action, p.3)

In response, claim 77 has been amended to recite that each graphical representation is prospectively indicative of the effect of the enhancement. Such an embodiment is illustrated in Fig. 4, elements 52a-d, which prospectively illustrate the changes in brightness that would occur for image 52’ if the user designation area associated with one of images 52a-d were to be selected (Specification, p.12, lines 1-6). In light of this explanation, it is submitted that the rejection under 35 USC §112, paragraph 1, has been overcome and should be withdrawn. If the Office maintains the rejection, Applicants respectfully request that a recommendation be provided that will resolve this rejection.

Rejection Under 35USC §112 Second Paragraph

Claims 44, 114, and 117 have been rejected under 35 USC §112, paragraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention.

Claim 44 has been amended to recite “the printer”, instead of “the system”.

Claims 114 and 117 have been amended to recite “wherein the processor-executable instructions, when executed by the processor, cause the processor to perform further operations comprising”.

In view of the foregoing, it is submitted that the rejections under 35 USC §112, paragraph 2, have been overcome and should be withdrawn. If the Office maintains the rejections, Applicants respectfully request that a recommendation be provided that will resolve the rejections.

Request for Affidavits Regarding Personal Knowledge Used in Rejections

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The Office has extensively relied on Official Notice to support rejections for a large number of claims, and for a wide variety of claimed features:

- For a printer to include a scanner and to print photos (claim 21, 43, 45, 46, 113, 123, 125, 129)
- To reinsert a form into an input/output tray of the printer (claim 22)
- For a printer to have a memory card reader or an I/O port (claim 23, 87)
- To print photos with microscopic pixels (claim 24, 88)
- To utilize bubble-shaped regions (claim 29, 90)
- To utilize a photo detector array, a paper edge sensor, a media type sensor, or an ink jet pen activation energy sensor (claim 33, 92)
- To utilize an electrical scanner or a mechanical scanner (claim 34)
- To utilize a direct data link to receive images in a printer (claim 39)
- For a printer to include a scanner and to print automatically (claims 47, 72, 73, 74, 85)
- For an identity marker to include printed and unprinted locations (claim 53)
- To mark a document by punching out holes, applying a sticker, or applying a conductive marker thereto (claim 58)
- To best-fit an image that has been cropped (claim 83)

37 CFR §1.104(d)(2) requires the Office's reliance on personal knowledge be appropriately supported. This section states:

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavit of the applicant and other persons."

Furthermore, Applicants respectfully note that, while certain of these features may, *arguendo*, be alleged to be commonplace today, the parent application of the present application was filed on 10/15/1998, and thus the patentability of Applicants' invention must be judged from the perspective of that date.

If any of the claims are found to not be allowable, Applicants respectfully request that the Office provide an affidavit pursuant to 37 CFR §1.104(d)(2) in a non-final Action for each fact based on personal knowledge which is relied on for a rejection.

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Rejection Under 35USC §103

Claims 21-24, 26-37, 39, 41, 43-58, 64-65, 68-70, 72-73, 113-114, 123-126, and 129 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of well known prior art. Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 43, and its dependent claim 44, is respectfully traversed for at least the following reasons. Claim 43 recites:

"43. (Currently amended) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, the printer comprising:
a digital print mechanism capable of generating graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas on a print medium;
a scanner mechanism capable of detecting at least one user designation area on the print medium after it has been completed by a user;
program logic configured to cause the digital print mechanism to generate a combination

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proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner mechanism to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner mechanism;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner mechanism; and

program logic configured to cause the digital print mechanism to automatically generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

First, claim 43 recites that the printer includes a digital print mechanism that generates on a print medium a combination proof sheet and order form that incorporates a graphical representation of at least one digitally stored image, and a plurality of user designation areas. The Hicks reference does not teach or suggest this limitation for several reasons. First, the images of the Hicks reference are not digitally stored images, but rather are film images:

"the exposed film is sent to the photographic lab and developed in known manner as represented by block 2. ... for each subject, the developed film, as seen in block 3, is marked with an identifying group code or name and a frame member, whereafter the film is adjusted for composition, whereafter the identifying data and the composition data are stored in a computer data base represented by block 12. Thereafter, as seen in block 4, the negatives are printed in proof form on a single sheet of proof paper or "contact sheet" using stored composition data from the computer data base, and an order form is printed on the same sheet of proof paper simultaneously with the printing of the proof prints. The order form is printed on the proof paper using either a computer generated image or a previously prepared photographic negative image." (col. 3, lines 10-28; emphasis added)

There is no teaching or suggestion in the Hicks reference that the film images are ever digitized or stored, even though composition data is stored in a computer data base. There is no digitizer disclosed or suggested in the Hicks reference that could convert the film negatives into a digital image file. Second, a digital print mechanism cannot be used to print film negatives,

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because film negatives do not store images as digital data, but rather as optical data. Instead, in order to print a contact sheet for the images on the film negatives, the Hicks reference must utilize optical photographic print production equipment and chemical processing adapted for making prints from film. Third, the combination proof and order form of the Hicks reference cannot be completely printed with any single print mechanism; at least two different print mechanisms are required. After the optical photographic print production equipment has printed the negatives on the sheet in proof form, "the group code, frame number and composition data are now imprinted on the proof paper using a mechanical or character printer mechanism programmed by group code, frame number, and composition data stored in the computer data base" (col. 3, lines 37-42).

Second, claim 43 recites that the digital print mechanism generates at least one final print sheet having a graphical representation of at least one of the digitally stored images. The Hicks reference does not teach or suggest this limitation for similar reasons as discussed above for the combination proof sheet and order form. Because the Hicks reference produces final prints from film negatives, these final prints are not graphical representations of digitally stored images, and thus cannot be printed on a digital printer.

Third, claim 43 recites that the digital print mechanism generates both the combination proof sheet and order form, and the final print sheets. There is no disclosure in the Hicks reference that a single print mechanism produces both elements. The photographic lab of the Hicks reference utilizes a large number of different pieces of equipment - silver halide film developing equipment, computers, scanners, mechanical printing equipment, as well as chemical and optical photographic print production equipment. Details of the precise nature of this equipment, and its interconnections, are not specified in Hicks. However, the system disclosed in the Hicks reference is directed towards a photographic lab business for producing photographic packages for institutional groups such as school children, church congregations, clubs and other organizations (col. 1, lines 10-13). Given the print volume of the lab, the likelihood that the lab would have multiple units of any particular type of equipment, and the

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setup time likely involved in converting a particular piece of photographic print production equipment from proof printing to final print generation, it is unlikely that a single print mechanism would produce both the combination proof and order sheet and the final prints.

Fourth, claim 43 recites that the digital print mechanism automatically generates the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user. In the Hicks reference, the final print sheets are not automatically generated (col. 4, lines 16-30). The Office states that "Official Notice is taken that it is well known and obvious for a printer to ... print automatically. Further, it is common for copiers [to] print automatically after a document is scanned." (Office Action, p.10-11, with regard to a similar limitation in claim 47). To whatever extent, if any, this assertion of the Office may be correct, it is believed that it is not well known and obvious for a printer to print final print sheets automatically in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user on a combination proof and order sheet. Copiers produce a duplicate copy of the document that is scanned. However, in Applicants' invention, the final prints produced are not duplicate copies of the scanned combination proof sheet and order form. Instead, the user-completed user designation areas on the scanned combination proof sheet and order form are detected and interpreted, and final prints generated in accordance with the user-completed areas.

Fifth, claim 43 recites that the printer includes the digital print mechanism and the scanner. The Office states that "Hicks '387 does not disclose expressly the printer with a scanner mechanism ... Official Notice is taken that it is well known and obvious for a printer to include a scanner" (Office Action, p.9). As noted above, Applicants respectfully request that the Office provide an affidavit regarding this assertion as to what was well known in 1998.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Furthermore, the Office has not established a *prima facie* case of obviousness at least

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because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006). A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. The Office states that the Hicks reference can be modified because the "motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer" (Office Action, p.10). Applicant believes that this reason is merely a recitation of features of a multifunction printer which is known today, not a rational underpinning as of 1998 for modifying the Hicks reference, and thus is insufficient for to support a conclusion of obviousness.

In addition, the amount and type of modifications to the photographic lab of the Hicks reference that would be required in order for the same to operate in the manner recited in claim 43 would be so significant that such a modification would not have had a reasonable expectation of success. The Hicks reference doesn't even store the actual images themselves, only the group identifying code and the composition data used to adjust the film are stored in the computer data base. As indicated in Fig. 1 of the Hicks reference, film is physically delivered to the photographic lab and then developed. Therefore Hicks doesn't have any means for receiving digitally stored images nor causing a digital printer to generate a combination proof sheet and order form that incorporates at least one of the plurality of images generated from the digital data. The modifications of the analog film photographic lab of Hicks that would be required to incorporate the ability to accept and process digital image data would be so substantial that no person of ordinary skill at the time the invention was made would attempt the same. Stated another way, the modification of Hicks proposed by the Office wouldn't even operate. Where prior art references taken in combination would produce a seemingly inoperative device, they teach away from the combination and cannot create a *prima facie* case of obviousness. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001).

Therefore, the rationale provided by the Office impermissibly uses the Applicants'

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disclosure as a blueprint or in hindsight for the rejection. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, it is improper to modify the Hicks reference and the rejection under 103(a) should be withdrawn at least for this reason.

Independent claims 47 and 72 (both currently amended) each recite limitations similar to those of claim 43, discussed above.

Claim 47 recites:

"47. (Currently amended) A method for selecting and printing digitally stored images available to a digital printer, comprising:
generating with the digital printer a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas;
scanning with the digital printer the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon;
detecting and interpreting the completed user designation areas with the digital printer;
and
automatically printing with the digital printer, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas." (emphasis added)

Claim 72 recites:

"72. (Currently amended) A method for selecting and printing digitally stored images, comprising:
receiving in a digital printer a plurality of the digitally stored images;
generating with the digital printer a combination proof sheet and order form that incorporates a graphical representation of at least one of the images and a plurality of user designation areas;
receiving with the digital printer the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon and the form has been re-inserted into the digital printer;
utilizing the digital printer to detect and interpret the completed user designation areas on the re-inserted combination proof sheet and order form; and
automatically generating with the digital printer, responsive to the detection and

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interpretation of the completed user designation areas, at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the completed user designation areas.” (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in that the features of a digital printer generating a combination proof sheet and order form that has a graphical representation of at least one digitally stored images and a plurality of user designation areas, the features of the same digital printer generating both the combination proof and order sheet and the final print sheets of the digitally stored images, and the features of automatically generating the final print sheets in response to the detecting and interpreting of user-completed areas on the combination proof and order sheet, are neither taught nor suggested by the Hicks reference in view of well known prior art.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection of independent claims 47 and 72, and dependent claims 48-58, 64-65, and 68-70, is improper at least for that reason and should be withdrawn.

Independent claims 21, 45, 46, 123, and 129 (all currently amended) each recite at least some limitations discussed above with regard to claim 43 and which patentably distinguish these claims from the cited references.

Claim 21 recites:

“21. (Currently amended) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

a scanner mechanism configurable by program logic to detect and interpret at least one

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user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause the digital print mechanism to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas." (emphasis added)

Claim 45 recites:

"45. (Currently amended) A system for enabling a user to select and print a plurality of digitally stored images, the system comprising:

a digital printer capable of generating graphical representations of selected ones of the plurality of images and a plurality of user designation areas on a print medium;

a scanner capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital printer to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner; and

program logic configured to cause the digital printer to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the user designation areas completed by the user." (emphasis added)

Claim 46 recites:

"46. (Currently amended) A system for enabling a user to select and print a plurality of digitally stored images, comprising:

a digital printer configurable by stored program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of images and a plurality of user designation areas;

a scanner coupled to the printer and configurable by stored program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner; and

program logic configured to cause the digital printer to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas." (emphasis added)

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Claim 123 recites:

"123. (Currently amended) A computer-readable medium storing a program for printing selected ones of a plurality of digitally stored images, comprising:

code that controls a digital print mechanism to generate a combination proof sheet and order form having graphical representations of the plurality of digitally stored images and a plurality of user designation areas;

code that controls a scanner mechanism to scan the combination proof sheet and order form after completion by a user;

code that detects on the scanned proof sheet and order form at least one user-completed one of the user designation areas;

code that interprets the at least one user-completed one of the user designation areas to identify at least one user-selected one of the images; and

code that controls the digital print mechanism to generate at least one final print of the at least one user-selected one of the images." (emphasis added)

Claim 129 recites:

"129. (Currently amended) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

means for generating with a digital print mechanism a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

means for detecting and interpreting at least one user-completed one of the user designation areas; and

means for generating with the digital print mechanism at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas." (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in that the features of a digital printer or print mechanism generating a combination proof sheet and order form that has a graphical representation of digitally stored images and a plurality of user designation areas, and the features of the same digital printer generating both the combination proof and order sheet and the final print sheets of the digitally stored images, are neither taught nor suggested by the Hicks reference in view of well known prior art.

Applicants respectfully traverse the Office's assertion that it would have been obvious to

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a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 21, 45, 46, 123, and 129, and their corresponding dependent claims 22-24, 26-37, 39, 41, and 124, is improper at least for that reason and should be withdrawn.

Independent claims 113 and 125 (both currently amended) each recite at least some limitations discussed above with regard to claim 43 and which patentably distinguish these claims from the cited references.

Claim 113 recites:

"113. (Currently amended) At least one processor-readable medium having processor-executable instructions therein which, when executed by a processor, cause the processor to perform operations comprising:

controlling a digital print mechanism to generate a combination proof sheet and order form having graphical representations of a plurality of digitally stored images accessible by the processor and a plurality of user designation areas;

controlling a scanner mechanism to scan the combination proof sheet and order form after completion by a user;

detecting on the scanned proof sheet and order form at least one user-completed one of the user designation areas; and

interpreting the at least one user-completed one of the user designation areas to identify at least one user-selected one of the images and at least one user-selected print characteristic associated with the at least one user-selected one of the images." (emphasis added)

Claim 125 recites:

"125. (Currently amended) A printer, comprising:

means for generating with a digital print mechanism a combination proof sheet and order form having graphical representations of a plurality of digitally stored images and a plurality of user designation areas;

means for detecting on the combination proof sheet and order form at least one of the user designation areas completed by a user;

means for interpreting the at least one user-completed one of the user designation areas so as to identify at least one user-selected one of the images and at least one user-selected print characteristic associated with the at least one user-selected one of the images." (emphasis added)

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For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in that the features of a digital print mechanism generating a combination proof sheet and order form that has graphical representations of digitally stored images and a plurality of user designation areas are neither taught nor suggested by the Hicks reference in view of well known prior art.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 113 and 125, and their corresponding dependent claims 114 and 126, is improper at least for that reason and should be withdrawn.

Independent claim 73 recites at least some limitations discussed above with regard to claim 43 and which patentably distinguish this claim from the cited references.

Claim 73 recites:

"73. (Previously presented) A method for selecting and printing digitally stored images, comprising:
generating a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas;
scanning the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon;
detecting and interpreting the completed user designation areas; and
automatically printing, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas." (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in that the features of automatically generating at least one final print in accordance with detected and interpreted completed user designation areas on the combination proof and order sheet are neither taught nor suggested by the Hicks reference in view of well known prior art.

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Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 73 is improper at least for that reason and should be withdrawn.

Claim 25 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of well known prior art and further in view of U.S. patent 5,398,131 to Hall ("Hall"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks reference have been discussed heretofore and against which the Hall reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 40, 59-62, 74-77, 79-93, 95, 117, and 127 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of well known prior art and further in view of U.S. patent 4,441,807 to Bartz ("Bartz"). Applicants respectfully traverse the rejection and request reconsideration.

The rejection of independent claim 74, and its dependent claims 75-77 and 79-84, is respectfully traversed for at least the following reasons. Claim 74 recites:

"74. (Currently amended) A method for enhancing a digitally stored image available to a digital printer, comprising:

generating with the digital printer a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable

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to the image;

scanning the form with the digital printer after a user has completed at least one of the user designation areas;

detecting and interpreting the completed user designation areas with the digital printer; and

automatically enhancing, responsive to the detecting and interpreting, the digitally stored image with the digital printer in accordance with the completed user designation areas." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

For similar reasons as explained above with regard to claim 43, the Hicks reference does not teach or suggest the features of generating with a digital printer a form having at least one graphical representation of a digitally stored image and a plurality of user designation areas each associated with at least one of the graphical representations. The Office does not cite the Bartz reference as teaching such features, and it is believed that the Bartz reference does not teach or suggest such features.

With regard to automatically enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas, the Office states that the Hicks reference does not disclose "a user designation area associated with image enhancement" (Office Action, p.18). However, the Office states that the Bartz reference discloses such an area in mark box column 18 and 19 of Fig. 1. To whatever extent, if any, the Office's position is correct, however, neither the Hicks nor the Bartz references, alone or in combination, teach or suggest the limitation of automatically enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas. The Hicks reference does not teach digital image enhancement at all; rather, the images of the Hicks reference exist on film negatives. With regard to detecting and interpreting completed user designation areas, the Hicks reference teaches, at most, that "order data from the order form may be automatically entered into the computer database by passing the combined print and order form through a suitable read device" (col. 4, lines 23-26). However, no automatic operations are

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performed on the film negative images. Nor does the Bartz reference teach digital image enhancement, or disclose any digitally stored images at all. Rather, the Bartz reference is directed to a masking card for film images: "A photographic printing system including an improved masking card. The masking card carries an image-bearing transparency at an aperture thereof" (Abstract). Thus the Bartz reference cannot teach or suggest any automatic enhancing of a digitally stored image.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006). A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. The Office states that the Bartz reference can be combined with Hicks reference because the "motivation for doing so would have been to allow the user to crop and choose the color of ordered prints" (Office Action, p.18). Applicant believes that this reason is merely a recitation of features disclosed in Applicants' invention. As such, the rejection relies on impermissible hindsight.

In addition, the Bartz reference teaches away from combining with the Hicks reference. The masking card of the Bartz reference is used to provide exposure parameters to the photographic printer. Such parameters include, for example, an exposure setting and a color balance setting to be used with the corresponding negative. However, the masking card cannot serve as a proof and order form to be filled in by a purchaser of finished prints, because these parameters are not known to the purchaser. Instead, they are determined by the photographic lab technician during printing of the negatives.

The Bartz reference further teaches away from combining with the Hicks reference in that

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the masking card does not include a proof print of the image, but includes the transparency (i.e. film negative) itself. Delivering the film negative to the potential purchaser runs the risk that the original photographic image could be lost or never returned to the lab. It also runs the risk that the potential purchaser might decide to take the film negative to his own local film processor for making less expensive prints, since the package price usually include other costs such as the cost of the original photography session at which the photos were taken. If the film negatives are not mounted to the masking card in order to prevent these risks, the combined invention would be inoperative because the user could not know which photograph corresponds to which masking card.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for this reason and should be withdrawn.

Independent claim 85 recites at least some limitations similar to those of claim 74, discussed above.

Claim 85 recites:

"85. (Currently amended) A printer for enabling a user to enhance a digitally stored image accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause a processor in the printer to enhance the digitally stored image in accordance with the completed user designation areas." (emphasis added)

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For similar reasons as explained heretofore with regard to claim 74, the features of the present invention are not taught or suggested by the cited references in that the features of a digital print mechanism for generating a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations are neither taught nor suggested by the Hicks reference in combination with the Bartz reference and well known prior art.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 85, and its dependent claims 86-93 and 95, is improper at least for that reason and should be withdrawn.

With regard to dependent claims 40, 59-62, 117, and 127, Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of these claims on one of independent claims 21, 47, 113, and 125, whose reasons for allowability over the Hicks reference have been discussed heretofore and against which the Bartz reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

In addition, dependent claim 40 is further patentably distinguishable because the applied references do not teach or suggest all the claim limitations thereof. Claim 40 recites:

"40. (Currently amended) The printer of claim 21 wherein the digital print mechanism is further configurable by stored program logic to generate a custom proof sheet and order form having at least one graphically represented image and user designation cropping areas along adjacent side edges of the image, the user designation cropping areas markable by the user to graphically indicate two-dimensional cropping positions for the image." (emphasis added)

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The Office admits that the Hicks reference does not disclose user designation cropping areas but takes the position that the Bartz reference discloses such areas in the form of "mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15" (Office Action, p.16). However, to whatever extent, if any, that such mark boxes are user designation cropping areas, they are not disposed along adjacent side edges (plural) of the image; rather, they are all disposed along a single side edge of aperture 14 (Bartz, Fig. 1). Furthermore, the mark box columns 18,19 do not graphically indicate two-dimensional cropping positions for the image, as do user designation cropping areas disposed along adjacent side edges of Applicants' specification (Fig. 4, series of equally spaces bubbles 67,68; Specification, p.12, lines 4-10).

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations, and thus the rejection of claim 40 is improper at least for this additional reason and should be withdrawn.

Claim 63 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of well known prior art, further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,426,481 to Slater ("Slater"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 47, whose reasons for allowability over the Hicks reference have been discussed heretofore and against which the Slater reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 78 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of well known prior art, further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,907,391 to Kobayashi

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("Kobayashi"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on dependent claim 77, whose reasons for allowability over the Hicks and Bartz references have been discussed heretofore and against which the Kobayashi reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Formalities

Allowable Subject Matter

Claim 71 has been objected to as being dependent upon a rejected base claim and has been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants appreciate the indication of allowable subject matter, and respectfully request that the rewriting of these claims in independent form be deferred until a future time.

Comments on Statement of Reasons for Allowance

Applicants agree with the Office's conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reason(s) set forth in the Office Action. In particular, Applicants wish to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular element(s) in the combinations. Applicants submit that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicants thus rely on the claims, as drafted, rather than any characterization in the Office Action.

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Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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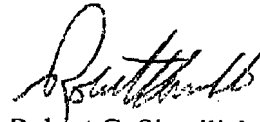
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If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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